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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/725,788	11/29/2000	Chun Yuen To	WWSM 2473	1169

321 7590 10/18/2002

SENNIGER POWERS LEAVITT AND ROEDEL  
ONE METROPOLITAN SQUARE  
16TH FLOOR  
ST LOUIS, MO 63102

EXAMINER

HENDERSON, MARK T

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 10/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

S.M.

**Office Action Summary**

Application No.

09/725,788

Applicant(s)

TO, CHUN YUEN

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(e). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                               | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4 and 5</u> . | 6) <input type="checkbox"/> Other:  |

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## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

### ***Reissue Applications***

1. While there is concurrent litigation related to this reissue application, action in this reissue application will NOT be stayed because of applicant's request that the application be examined at this time. Due to the related litigation status of this reissue application, EXTENSIONS OF TIME UNDER THE PROVISIONS OF 37 CFR 1.136(a) WILL NOT BE PERMITTED.

However, applicant can petition for an extension of time under the provisions of 37 CFR 1.136(b).

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***Oath/Declaration***

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

2. Receipt is acknowledged of papers filed under 35 U.S.C. 119 (a)-(d) based on an application filed in the United Kingdom on September 4, 1995. Applicant has not complied with the requirements of 37 CFR 1.63(c), since the oath, declaration or application data sheet does not acknowledge the filing of any foreign application. A new oath, declaration or application data sheet is required in the body of which the present application should be identified by application number and filing date.
3. Claims 18-29 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

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***Claim Rejections - 35 USC § 251***

4. Claims 18-29 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The original claim limitation of application 08/707,398 disclosed that the “upper structure” was “substantially rigid”. In Paper No. 18 of the same application, the applicant had presented the examiner with an amendment that “stresses” the limitation that the “upper structure” had to be “substantially rigid” and further “integral”. As a result, this amended limitation was approved for the allowance of the application. In the reissue application 09/725,788, Applicant is now trying to recapture the broadened claimed limitation surrendered in the previous application for patent.

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***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7, 8, 12-17, and 19-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. In Claim 7, it is not understood by what is meant by "upstanding". Which direction is up?

6. Claim 8 recites the limitation "the upper end" in line 3. There is insufficient antecedent basis for this limitation in the claim.

7. Claim 12 recites the limitation "upper end" in line 3. There is insufficient antecedent basis for this limitation in the claim.

8. Claim 13 recites the limitation "upper end" in line 9. There is insufficient antecedent basis for this limitation in the claim.

9. Claim 15 recites the limitation "engagement member" in line 2. There is insufficient antecedent basis for this limitation in the claim.

10. Claim 16 recites the limitation "the plate" in line 2. There is insufficient antecedent basis for this limitation in the claim.

11. Claim 17 recites the limitation "the plate" in line 4. There is insufficient antecedent basis for this limitation in the claim.

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12. Claim 19 recites the limitations: "a free end" and "the end" in line 11. There is insufficient antecedent basis for this limitation in the claim.

13. Claim 21 recites the limitation "the same plane" in line 2. There is insufficient antecedent basis for this limitation in the claim.

14. Claim 28 recites the limitation "the same length" in line 11. There is insufficient antecedent basis for this limitation in the claim.

15. Claim 29 recites the limitations "the same plane" in line 12. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 1-29, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Schuessler (5,160,209).

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Schuessler discloses in Fig. 6-9, a ring binder comprising: a rigid integral upper structure (44), having a recess (50A) with which an end of an engagement portion (56, seen in Fig. 6) is deformable to engage (as seen in Fig. 6); a pivotable lower structure (Fig. 6) supported by the upper structure; ring members (46) mounted to the lower structure (seen in Fig. 6); at least one integral securing means and fastener (16 and 18, as seen in Fig. 1 and 2) for securing the ring binder to a base member (12); wherein the securing means includes an upstanding engagement portion (56, seen in Fig. 6, and Col. 7, lines 55-62, wherein the free ends of the post are "peened" to secure the upper structure to the surface of the base member); a plurality of deformed downward depending securing elements (62) for securing the ring binder to the base member, and further having an arcuate configuration (Col. 7, lines 20-25, wherein the securing elements depend from a plate (54), which abuts the base member (seen in Fig. 6); wherein the longitudinal axis of the ring binder is transverse to the longitudinal axis of the engagement portion; and wherein the plate member is parallel to the longitudinal axis of the ring binder; and wherein the engagement portion can be integrally formed with the plate member (Col. 6, lines 65-68), and further wherein the securing elements can be integrally formed with the plate member (Col. 7, lines 14-20).

Schuessler further discloses: wherein the securing elements have substantially the same length (Col. 7, lines 23-27), wherein the ends lie in the same plane.

However, Schuessler does not disclose: wherein at least 75% of the elements extend away from a longitudinal axis of the engagement portion.



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In regards to **Claims 1-3, 13, 18, and 19**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the securing elements to extend in any desirable direction and positioned at any desirable location, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

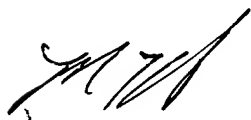
***Prior Art References***

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Cooper, Cooper et al, Cohen, Davies, Whaley et al, Whaley, Cheng et al, Whaley ('265) disclose a ring binder.

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**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

October 16, 2002